

Claims 19 to 28 stand rejected as being based upon a defective Oath under 35 USC 251, but it is requested that this rejection be held in abeyance until this application is in condition for allowance.

Patent Owner also notes that "applicant is advised to maintain a clear line of demarcation between the instant claims and the claims of the parent file", U.S. Patent No. 5,301,941 to avoid double-patenting. The Patent Owner will attempt to comply with the Examiner's request.

Claims 19 to 26 and 28 have been rejected as being an improper recapture of claimed subject matter in the original patent, U.S. Patent No. 5,301,941, with the statement:

"Claims 19-26 and 28 are rejected under 35 U.S.C. 251 as being an improper recapture of claimed subject matter deliberately canceled in the application for the patent upon which the present reissue is based. As stated in *Ball Corp. v. United States*, 221 USPQ 289,295 (Fed.Cir.1984):

The recapture rule bars the patentee from acquiring, through reissue, claims that are of the same or broader scope than those claims that were canceled from the original application.

Applicant's attention is drawn to MPEP Section 1412.02, which states that:

Impermissible recapture occurs in a reissue where the claims in the reissue are of the same scope as, or are broader in scope than, claims deliberately canceled in an application to obtain a patent. Where such claims also include some narrowing limitation not

present in the claims deliberately canceled in the application, the examiner must determine whether that narrowing limitation has a material aspect to it. If the narrowing limitation has a material aspect to it, then there is no recapture. However, if the narrowing limitation is incidental, mere verbiage, or would be inherent even if not recited (in view of the specification), then the claims should be rejected under 35 U.S.C. Section 251.

Applicant's attention is also drawn to the decisions *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed.Cir.1997), as well as *Hester Industries, Inc. v. Stein, Inc.*, before the United States Court of Appeals for the Federal Circuit, decided May 07, 1998.

In this case, and as to claims 19-26, these claims raise the question of recapture of claimed subject matter, since these claims are both broader and narrower in scope than claims amended to secure an allowance in the application for the patent upon which the present reissue is based. While these claims present some narrowing limitations, it has been determined that the narrowing limitations do not have a material aspect to them. More specifically, claims 19-26 and 28 are fashioned similar to claim 15 of the original patent (U.S. Pat. No. 5,301,941) to which this reissue pertains. Claims 19-26 and 28, however, lack the recitation of 'substantially uniform thickness' in describing the body wall, said limitation being included within patented claim 15 to distinguish over the art of record during the prosecution history of the application of the patent. With the 02/02/04 amendment, applicant has instead chosen to use the language 'being substantially planar and relatively thin' to describe the characteristics of the ball striking wall, in at least claims 19-26. It is noted that the newly proposed language 'substantially planar and relatively thin' contains no vestige of the original limitation 'substantially uniform thickness' used in the original patented claims. In

other words, claims 19-26 are broader in that claims 19-26 eliminate the requirement for a uniformly thickened ball striking wall. If the newly proposed language could possibly be construed as narrowing to any degree, it would further be noted that the narrowing limitation of 'planar and relatively thin' does not save claims 19-26 from the recapture doctrine, since during the prosecution of the original patent, the applicant added language relating to the shape and size of the body wall(i.e., a body wall of uniform thickness) in order to overcome the prior art of record.

With the 09/12/2003 amendment, Claim 28 is drafted absent any recitation regarding a 'substantially uniform thickness' criteria. Thus, claim 28 is broader in scope than claims amended to secure an allowance in the application for the patent upon which the present reissue is based. In addition, at least claim 19 of the 02/02/2004 amendment calls for a face height of 'about 1.4 inches', where in fact the original patent claims(i.e., claim 15 of U.S. Patent 5,301,941) call for a face height of 'at least 1.40 inches'.

The above rejection is not different from that raised in the Office Action of December 24, 2003, wherein the Examiner stated:

"Applicant's attention is also drawn to the decisions *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161(Fed.Cir.1997), as well as *Hester Industries, Inc. v. Stein, Inc.*, before the United States Court of Appeals for the Federal Circuit, decided May 07, 1998. In this case, and as to claims 19-22 and 24-26, these claims raise the question of recapture of claimed subject matter, since these claims are broader in scope than claims amended to secure an allowance in the application for the patent upon which the present reissue is based. While the claims present some narrowing limitations, it has been determined that the narrowing limitations do not have a material aspect to them.

Claims 19-22 and 24-26 are fashioned similar to claim 15 of the original patent (U.S. patent No. 5,301,941) to which this reissue pertains. Claims 19-22, 25 and 26, however, lack the recitation of "1.4 inches" in describing the face height, said limitation being included within patented claim 15 to distinguish over the art of record during the prosecution history of the application of the patent. Claim 24 lacks the recitation of 'substantially uniform thickness' in describing the body wall, said limitation being included within patented claim 15 to distinguish over the art or record during the prosecution history of the application of the patent."

Firstly, this rejection is largely moot because in the above Amendment all of Claims 19 to 26 contain either the 1.4 inch face height or the 1.625 inch face height minimums.

With respect to the Examiner's statement regarding Claim 24 that it does not contain the recitation of "substantially uniform thickness", this argument is also believed mooted by the amendment in all of the Claims. That is, all of the Claims have been amended herein by reciting instead of "substantially uniform thickness", that the face wall be "substantially planar and relatively thin". This new language can possibly be argued to be broader in some respects and narrower in other respects than the term "substantially uniform thickness". In any event, it more appropriately defines the distinction between the face wall

in the present application and the non-planar very thick face wall prior art cited against Claims 12 and 15 in the original patent application.

The Examiner cites the cases of *Hester Industries Inc. v. Stein Inc.*, (CAFC 1998), 46 USPQ2d 1641; *In re Clement*, (CAFC 1997), 45 USPQ2d 1161; *Mentor Corp. v. Coloplast Inc.*, (CAFC 1993), 27 USPQ2d 1521; and *Ball Corporation v. United States*, (CAFC 1984), 221 USPQ 289.

In the prosecution of application Serial No. 882,561, that matured into the patent sought to be reissued, U.S. Patent No. 5,301,941, original Claim 20 was amended on July 30, 1993, as follows:

20. (Amended) A high impact golf clubhead, comprising: a metallic body having a substantially flat ball striking wall on one side thereof angularly related to a vertical plane to provide clubhead loft, said ball striking wall having a plurality of generally parallel grooves therein and a face height of at least 1.40 inches, said body wall having a substantially uniform thickness, said body wall having a [head] heel portion and toe portion, said body having an integral hosel for receiving one end of a club shaft, means

for perimeter weighting the body including an integral metallic perimeter wall surrounding at least a major portion of the body wall and extending rearwardly therefrom forming a cavity in the rear of the clubhead with a bottom defined by the back of the ball striking wall, and means for increasing the perimeter weighting of the clubhead and increasing the radius of gyration of the clubhead including an extension of the heel portion of the body wall a substantial distance on the side of the hosel opposite the wall toe portion and perpendicular to the target line defining an extended heel portion and an extension of the perimeter wall around the perimeter of the extended heel portion of the ball striking wall, said hosel having an axis, said extension of the body wall and said extension of the perimeter wall not being greater than .625 inches from the hosel axis in a direction perpendicular to the hosel axis.

The appropriate analysis in all of the recapture cases is to compare the reissue claim with the corresponding original application claim prior to the amendment.

The reason for this is that an original application claim, prior to the amendment, is the subject matter that has been surrendered under recapture law.

Claim 20, prior to the July 30, 1993 amendment, reads as follows:

20. A high impact golf clubhead, comprising:
a metallic body having a substantially flat ball striking wall on one side thereof angularly related to a vertical plane to provide clubhead loft, said body wall having a head portion and toe portion, said body having an integral hosel for receiving one end of a club shaft, means for perimeter weighting the body including an integral metallic perimeter wall surrounding at least a major portion of the body wall and extending rearwardly therefrom forming a cavity in the rear of the clubhead with a bottom defined by the back of the ball striking wall, and means for increasing the perimeter weighting of the clubhead and increasing the

radius of gyration of the clubhead including an extension of the heel portion of the body wall a substantial distance on the side of the hosel opposite the wall toe portion and perpendicular to the target line defining an extended heel portion and an extension of the perimeter wall around the perimeter of the extended heel portion of the ball striking wall.

Claim 21, in the reissue continuation application, U.S. Serial No. 880,748, reads as follows:

21. A high impact golf clubhead, comprising: a metallic body having a substantially flat ball striking wall on one side thereof angularly related to a vertical plane to provide clubhead loft, said ball striking wall having a plurality of generally parallel grooves therein and a face height, said ball striking wall having a substantially uniform thickness, said ball striking wall having a heel portion and a toe portion, said body having an integral hosel for receiving one end of a club shaft, means for perimeter weighting the body including an integral

metallic perimeter wall surrounding at least a major portion of the ball striking wall and extending rearwardly therefrom forming a cavity in the rear of the clubhead with a bottom defined by the back of the ball striking wall, and means for increasing the perimeter weighting of the clubhead including an extension of the heel portion of the balls striking wall a substantial distance on the side of the hosel opposite the wall toe portion and perpendicular to the target line defining an extended heel portion and an extension of the perimeter wall around the perimeter of the extended heel portion of the ball striking wall, said hosel having an axis, said extension of the ball striking wall and said extension of the perimeter wall not being greater than 0.562 inches from the hosel axis in a direction perpendicular to the hosel axis.

The underlined portions of this Claim 21 are not contained in an original Claim 20, and the non-underlined portions are absolutely identical to the wording of un-amended Claim 20.

Thus, since Reissue Claim 21 is more specific in every respect than unamended(original) Claim 20, and not broader in any respect than unamended Claim 20, the recapture rule does not apply at all.

As stated by the CAFC in the *In re Clement* case, at 1165:

"In both *Mentor* and *Ball*, the relevance of the prior art rejection to the aspects narrowed in the reissue claim was an important factor in our analysis. From the results and reasoning of those cases, the following principles flow: (1) if the reissue claim is as broad as or broader than the canceled or amended claim in all aspects, the recapture rule bars the claim; (2) if it is narrower in all aspects, the recapture rule does not apply, but other rejections are possible; (3) if the reissue claim is broader in some aspects, but narrower in others, then: (a) if the reissue claim is as broad as or broader in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claim; (b) if the reissue claim is narrower in an aspect germane to prior art rejection, and broader in an aspect unrelated to the rejection, the recapture rule does not bar the claim, but other rejections are possible. *Mentor* is an example of (3)(a); *Ball* is an example of (3)(b).

In our case, reissue claim 49 is both broader and narrower in areas relevant to the prior art rejections." (emphasis added)

The present case falls in situation 2: "If it is narrower in all aspects, (from the cancelled Claim, Claim 20, prior to amendment being equivalent to the cancelled

subject matter), the recapture rule does not apply." For this reason alone, the surrender-recapture rule does not apply, and Claim 21, as well as Claims 25, 26, and 29, are not subject to the recapture doctrine.

However, in an abundance of conservativeness, these recapture cases can be distinguished on other grounds because they present different factual situations, and when the doctrine is applied, they are cases where the reissuing party is attempting to completely redefine the invention.

In the present situation, original Claim 20 was amended to include six limitations "not found in the Reuter putter". These six limitations were described as follows in the July 30, 1993, Amendment:

- "1. A 'high impact' golf club head and face wall;
2. 'a perimeter wall defining a hollow area generally centrally behind the forward wall';
3. 'said forward wall having -- a plurality of generally parallel grooves therein';
4. 'said extension of the forward wall and the perimeter wall not being greater than .625 inches from the axis of the hosel in a direction perpendicular to the hosel axis';
5. 'said forward wall having a substantially uniform thickness to reduce clubhead weight';
6. 'said ball impacting face wall having a vertical height of at least 1.4 inches'."

And the following discussion followed:

"All six of these limitations are completely missing from the Reuter putter and are not believed obvious in view of Reuter. It must be remembered that putter design and golf club head design have traveled down two completely diverse tracks over the last 24 years. The long heel portion 13 in the Reuter putter renders his clubhead illegal under the USGA Rules for metal woods and irons. This is another reason why Reuter's putter is non-analogous prior art."

The Examiner, in the present case, knows fully well that face heights at 1.4 inches are common in woods and irons, and this limitation was not placed in the Claim to define over woods and irons, but really to distinguish the invention from putters. The invention defined in Claim 20, as well as most of the other Claims involved in this reissue, relate to the inset hosel configuration and not the height of the face. No other comments other than the brief one above with respect to face height were made in the entire prosecution of the application underlying the patent sought to be reissued here. And very importantly, there are no comments by the Examiner placing any reliance on the face height limitation as defining over prior art.

In the *Hester* case, the patentee sought by reissue to eliminate two limitations in the original patent; namely, "solely with steam" and "two sources of steam". These limitations were argued by the patentee to be the primary limitations defining over the prior art, and the patentee

made these arguments some 27 times, including in two appeal briefs before the Board of Patent Appeals. A critical aspect of the case is that the Board specifically relied on these two limitations in reversing the Examiner and allowing the patent claims.

The reissue claims, therefore, were directed to a completely different invention than defined in the original patent. It is not at all surprising that the Court of Appeals for the Federal Circuit ruled the way it did in the *Hester* case.

The *Hester* Court found(USPQ2d at 1647):

"We share the district court's discomfort with Williams' attempt to remove, through reissue, the 'solely with steam' and 'two sources of steam' limitations after having relied so heavily on those limitations to obtain allowance of the original patent claims over the prior art.

As detailed above, Williams repeatedly argued that the 'solely with steam' and 'two sources of steam' limitations distinguished the original claims from the prior art. These were Williams' primary bases for distinguishing the broadest claim, independent claim 1, from the prior art. At no less than 27 places in six papers submitted to the Patent Office, Williams asserted that the 'solely with steam' limitation distinguished the claimed invention from the prior art, and Williams did the same with respect to the 'two sources of steam' limitation at no less than 15 places in at least five papers.

Williams argued that each of these limitations was 'critical' with regard to patentability, and Williams further stated that the 'solely with steam' limitation was 'very

material' in this regard. In essence, these repeated arguments constitute an admission by Williams that these limitations were necessary to overcome the prior art. Indeed, when the Board reversed the Examiner's rejection of the original claims, these were the primary bases indicated for patentability. Williams, through his admission effected by way of his repeated prosecution arguments, surrendered claim scope that does not include these limitations." (USPQ2d at 1649)

Thus, *Hester* can be distinguished because the patentee argued 27 times in 6 different papers the two limitations were critical to his invention and these limitations were expressly relied on by the Board in allowing the claims.

In the *Clement* case, which is even a more outrageous set of facts than the *Hester* case, the patentee sought by reissue to delete some 8 (eight) limitations that were added by amendment in the original application all to define over prior art. The *Clement* patent related to a method of treating waste paper to remove contaminants, such as adhesives, as well as ink particles and included steps (A) forming -- (B) separating -- (C) softening -- (C) detaching -- and (E) removing --. Reissue Claim 49 was more specific than the pre-amended patent Claim in that it included "at least 59 ISO in the final pulp", but was broader in 8 respects in that it eliminated the room temperature limitation and specific energy limitations in step A; it

eliminated the temperature, specific energy, and PH values in step C; and eliminated the temperature, specific energy and PH values in step D.

All of these limitations were added in the original application to overcome prior art.

It is clear that the *Clement* Court was influenced by the fact that the subject matter eliminated was far more material than the subject matter added in Reissue Claim 49. Note the following statement by the Court:

"On balance, reissue claim 49 is broader than it is narrower in a manner directly pertinent to the subject matter that Clement surrendered throughout the prosecution. Even with the additional limitations, claims 50-52 are also broader than they are narrower in a manner directly pertinent to the subject matter that Clement surrendered during prosecution."

On balance, the present Reissue Claim 21 is narrower in five respects than Claim 20 prior to the July 30, 1993 amendments in a manner directly pertinent to the subject matter of the invention.

The *Ball* case, in which the Court of Appeals in 1984 found that the recapture rule did not apply, related to an invention of a dual slot antenna assembly intended for use on missiles. During the prosecution of the original application, Claims 7, 8 and 9, which were cancelled subsequently, did not include the limitation of "a plurality of feed lines". The Examiner suggested the allowability of the

plurality of feed lines if presented in independent form and following the second Office Action, *Ball* added that limitation to the claims that were eventually matured into patent claims.

Reissue Claim 5 did not include a plurality of feed lines, and the Government contended that *Ball*'s deliberate cancellation of the single feed line claim was not error, and that that act was taken to avoid a prior art rejection, and in the Government's view, the recapture rule barred *Ball* from securing similar claims through reissue.

The Court of Appeals for the Federal Circuit stated in discussing the *Ball* facts:

"The CCPA has repeatedly held that the deliberate cancellation of claims may constitute error, if it occurs without deceptive intent" citing the *Wadlinger*, 496 F.2d at 1206, 181 USPQ at 831.

The Court then went on to state:

"The Ninth Circuit employed a more rigid standard in *Riley v. Broadway-Hale Stores, Inc.* stating: 'when the chief element added by reissue has been abandoned while seeking the original patent, the reissue is void.' The trial judge sought to determine whether *Ball* has made a deliberate judgment that claims of substantially the same scope as the new reissue claims would have been unpatentable. The Government, arguing from *Riley*, submits that the trial judge's approach loses sight of the feature given up by a patentee in order to secure the original patent. We decline to adopt the rigid standard applied in *Riley*, in favor of the more liberal approach taken by the CCPA. *Petrow* clearly es-

tablishes the vitality of the standard employed by the trial judge under this court's precedent."

It is noteworthy that the *Ball* Court, as well as the *Clement* Court, compared the reissue claims to the cancelled claims, rather than the claims as amended, as evidenced by the following statement (noting the above comparison to original Claim 20 without the July 30, 1993 amendments):

"The canceled claims, claims 7 and 8, define the invention quite broadly. Canceled claim 8 requires feed means including at least one conductive lead. The reissue claims, in contrast, include limitations not present in the canceled claims: the cavity is filled with a dielectric material; and an electrical signal feed assembly replaces the feed means of the canceled claims. The electrical signal feed assembly (Fig. 6) is a network of leads with a single coaxial feedline to that network. The network consists of a plurality of thin ribbon-like conductive leads.

Feed points 53 to the outer conductor are one wavelength apart at the anticipated operating frequency of the antenna. The leads of this network 52, 54, 56, 58, are dimensioned to provide continuous impedance matching between the cavity and the single coaxial feedline 70, which feeds into the assembly at the aperture 48. The signal feed assembly is more limited than the 'at least one' feed means limitation of canceled claim 8."

Thus, the reissue claims in *Ball* were, in several respects, as in the present case, more specific than the cancelled Claims 7 and 8. The Court, however, noted that

the reissue claims were in fact broader in one respect, with respect to the cancelled claims(which is not the case here), and made the following statement:

"The reissue claims are, however, broader in one respect. The canceled claims are limited to an antenna of cylindrical configuration, whereas the reissue claims are not so limited. We are aware of the principle that a claim that is broader in any respect is considered to be broader than the original claims even though it may be narrower in other respects. That rule will not bar Ball from securing the reissue claims here on appeal."

Thus, in the Ball case, the facts are even weaker for no recapture than the present case because in Ball, the reissue claims had some five limitations more specific than cancelled claims 7 and 8, but one limitation, the cylindrical antenna configuration, that was broader than the cancelled claims.

In summary, it is apparent that the reissue cases finding the recapture rule to apply, involve factual situations in which there were many limitations deleted from the original claims in the reissue claims combined with a heavy reliance by the patentee and the Patent Office in allowing the claims over prior art based specifically on these limitations. In contrast, the cases finding the recapture rule not to apply involve a single limitation, such as found

in the present case where there does not appear to be any reliance by the Examiner on the critical nature of such limitation.

Claims 19 to 26, not Claim 28, have been rejected under 35 USC 112 because of an alleged failure of the original specification to mention a planar ball striking face or a thin ball striking face, with the statement:

"The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

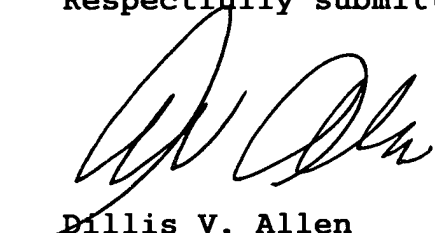
Claims 19-26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, the language 'substantially planar and relatively thin' is deemed to be new matter. Nowhere within the confines of the original specification is there any mention whatsoever of a planar ball striking wall or face, much less any mention of what is considered to be relatively thin when discussing the front face or forward wall."

If the Examiner will refer to the drawings, and particularly Figs. 9 to 16, they fully support the proposition that the face wall 16 is both planar and thin. Note that the wall 16, both in Fig. 10 and in Fig. 14, is very thin compared to its length and height. The instant Examiner is highly knowledgeable and understands that the drawings, as filed, constitute part of the original disclosure, and the fact that the face wall is both planar and thin is not specifically set forth in that language in the written specification does not mean that it is not supported by the specification as a whole, and particularly in this case, the drawings. Furthermore, column 7 of the '941 patent in the first sentence of the fourth full paragraph, the statement appears: "The thickness of wall 16 is 0.070 inches", which is certainly thin. In fact, wall 16, even with the urethane insert 12 is also relatively thin because as noted in the following paragraph: "The insert 12 has a depth from its forward surface 26 to the forward surface of face wall 16 of 0.200 inches so that the insert projects forwardly from the forward surface 31 and the unit-cell structure 18 a distance of 0.050 inches, all resulting in a total composite forward wall thickness of 0.270 inches."


For the above reasons, it is respectfully requested that the rejection of Claims 19 to 26 based on indefiniteness be withdrawn.

As Patent Owner has made a good faith effort to place this application in condition for allowance, reconsideration and issuance are respectfully requested.

Respectfully submitted,


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